

REMARKS

Applicants respectfully request reconsideration in view of the following remarks and amendments. Claims 1, 7, 9, 10, 13, 18-20, 26, 30, 32-34, 39, and 40 are amended. Accordingly, claims 1-49 are pending in the application.

I. In the Specification

Applicants have amended the Specification to include previously omitted element 604 shown in Fig. 6 as originally filed. Therefore, Applicants submit that no new matter has been introduced because the amendments are made solely to include previously omitted subject matter illustrated in Fig. 6 as originally filed.

II. Claims Rejected Under 35 U.S.C. § 102

Claims 1-15 and 18-49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,266,583 issued to Fitzpatrick et al. (hereinafter “Fitzpatrick”). To establish an anticipation rejection the Examiner must show that the cited reference teaches each element of a claim.

Claim 1, as amended, recites the elements of “the logic enables the second user to act as an intermediary in response to a request by the first user to add a contact associated with the second user.” Support for the amendments may be found, for example, on page 16, line 25 to page 17, line 2 and page 18, lines 3-15 of the Specification. Fitzpatrick fails to teach these elements. Fitzpatrick discloses a system that provides contact management for chat session participants. See Fitzpatrick, column 4, lines 45 and 46. During a chat session, Fitzpatrick teaches that a first user may browse and add contacts into the first user’s contact list from another user’s contact list. See Fitzpatrick, column 8, lines 36-40. However, Fitzpatrick fails to teach that the other user acts as an intermediary in a case where the first user views the other user’s contact list and then requests adding a contact from the other user’s contact list. This is because upon allowing the first user to view the contact list of another user, the first user may fully view and add contacts *without notifying the other user of this activity*. See Fitzpatrick, column 8, lines 48-55. In other words, when the user has sufficient security credentials, the accessing and viewing of the other user’s contact list is

unrestricted and independent of the other user. See Fitzpatrick, column 8, lines 62-66. Without sufficient security credentials, the first user is *not permitted to access nor view* the contact list of the other user. See Fitzpatrick, column 6, lines 33-38. Therefore, with sufficient security credentials, the first user may add contacts from the other user's contact list without the other user performing the role as a mediator (i.e., "intermediary"). Consequently, for at least these reasons, Fitzpatrick fails to teach the elements of "the logic enables the second user to act as an intermediary in response to a request by the first user to add a contact associated with the second user," as recited in claim 1. Accordingly, reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

With respect to dependent claims 2-12, these claims depend on claim 1 and incorporate the limitations thereof. Therefore, dependent claims 2-12 are patentable over the cited art for at least the reasons discussed in connection with claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 2-12 are respectfully requested.

Claim 13, as amended, recites the elements of "a description-based search means executable by users to search *the profile information stored in* the repository for one or more other users based on search criteria entered by the searching user, *the one or more other users being new contacts to the searching user*" (emphasis added). Support for the amendments may be found, for example, in page 20, lines 9-19 and Fig. 6 of the Specification. Fitzpatrick fails to teach these elements. Instead, during a chat session, a first user in the chat session may view the profile information of *another user in the chat session*. See Fitzpatrick, column 1, lines 37-42. However, viewing the profile information of the other user in the chat session is not equivalent to the elements of "search the profile information . . . for one or more other users," and "the one or more other users being new contacts" because the other user in the chat session is a *known contact* to the first user. This conclusion is supported because, during the chat session, upon a comparison of the respective contact lists of the first user and the other user, the non-included contacts of the respective contact lists *do not include the first and the other user*. See Fitzpatrick, column 8, lines 11-19. Moreover, as shown in Fig. 2, these non-included users from the comparison are *not chat session participants*. Therefore, the system in Fitzpatrick restricts the viewing of profile information to *known users in the chat session*. Consequently, Fitzpatrick fails to teach the elements of "search the profile

information . . . for one or more other users,” and “the one or more other users being new contacts” Thus, for at least the reasons set forth above, Fitzpatrick fails to teach each element of claim 13. In addition, dependents claims 14 and 15 are patentable over the cited art because each of these claims depends on claim 13. Accordingly, reconsideration and withdrawal of the rejection of claim 13-15 are respectfully requested.

With respect to independent claims 18 and 39, these claims recite elements similar to those in claim 13, namely the involvement of a search using the query to find new contacts for a user initiating the field-independent search query. Therefore, claims 18 and 39 are patentable over the cited art for at least the reasons discussed in connection with claim 13. Moreover, dependent claims 19 and 40-49 are patentable over the art of record because each of these depends on either base claim 18 or 39. Accordingly, reconsideration and withdrawal of the rejection claims 18, 19 and 39-49 are respectfully requested.

With respect to independent claims 20 and 30, these claims, as amended, recite some analogous limitations to those in claim 1, particularly where the second instance acts as an intermediary in response to a request by the first user to add a contact in the contact list of the second instance. Thus, in view of at least the reasons discussed above in connection with these limitations of claim 1, Fitzpatrick fails to teach each element of claims 20 and 30 as well. Further, dependent claims 21-29 and 31-38 are patentable over the cited art because each of these claims depends on either claim 20 or 30. Accordingly, reconsideration and withdrawal of the rejection claims 20-38 are respectfully requested.

III. Claims Rejected Under 35 U.S.C. § 103

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitzpatrick in view of U.S. Patent No. 6,690,918 issued to Evans et al. (hereinafter “Evans”).

With respect to claims 16 and 17, these claims depend on base claim 13 and incorporate the limitations thereof. Thus, for at least the reasons discussed in connection with claim 13, Fitzpatrick fails to teach or suggest each element of claims 16 and 17 as well. Moreover, Evans fails to cure these deficiencies. The Examiner has not cited and Applicants are unable to discern the portion of Evans that allegedly teaches or suggests the missing

elements of claim 13. Consequently, Fitzpatrick in view of Evans fails to teach or suggest each element of claims 16 and 17. Accordingly, reconsideration and withdrawal of the rejection claims 16 and 17 are respectfully requested.


CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (408) 720-8300.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: October 22, 2008



Marina Portnova
Reg. No. 45,750

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(310) 207-3800